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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,459	07/16/2001	Gilles Guichard	99 BB CNR URE	9090

466 7590 09/18/2002  
YOUNG & THOMPSON  
745 SOUTH 23RD STREET 2ND FLOOR  
ARLINGTON, VA 22202

EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/904,459

Applicant(s)

Guichard et al.

Examiner

Bruck Kifle, Ph.D.

Art Unit

1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) ☒ Responsive to communication(s) filed on 6/3/02 and 7/23/02

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4) ☒ Claim(s) 1-39 is/are pending in the application.

4a) Of the above, claim(s) 10, 11, 15-26, and 31-39 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-9, 12-14, and 27-30 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1

6) ☐ Other:

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*Election/Restriction*

Applicant's election with traverse of the compound Ii of page 96 in Paper No. 9 is acknowledged. The traversal is on the ground that "the outstanding Official Action fails to establish that an unduly extensive and burdensome search is required." This is not found persuasive because the compounds embraced the claims are patentably distinct and independent. The search required for a compound having different heterocycles is separate for each heterocycle (classified in classes 540-549). The search required for the elected compound (class 548, subclass 542) is not required for, say, compounds Ia or Ib (classified in class 560). The claims are drawn to structurally dissimilar compounds which are made and used independently. They are independent and distinct.

If, say, all else being identical, compounds containing the elected 2,5-dioxo-pyrrolidinyl group were anticipated, applicants would not acquiesce in the rejection of compounds containing other heterocycle or no heterocyclic groups at the same position thereover or vice-versa.

The search and examination of the entire scope of the claims presents an undue burden on the office because the compounds are classified separately and separate searches would be required.

Should applicants traverse on the ground that the groups are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing these groups to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the groups unpatentable over the prior art, the evidence or admission may

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and will be used in a rejection under 35 U.S.C. 103(a) of the other invention. Applicants, however, have not so stated.

Claims 10, 11, 15-26 and 31-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected subject matter.

***Improper Markush Rejection***

Claims 1-9, 12-14 and 27-30 are rejected under a judicially created doctrine as being drawn to an improper Markush group, that is, the claims lack unity of invention. The compounds of the instant claims are defined in such a way that they keep changing the core of the compound that determines the classification. By changing the values of the different variables, several patentably distinct and independent compounds are claimed. In order to have unity of invention the compounds must have "a community of chemical or physical characteristics" which justify their inclusion in a common group, and that such inclusion is not repugnant to principles of scientific classification" In re JONES (CCPA) 74 USPQ 149 (see footnote 2). The instant claims do not have a significant structural feature that is shared by all of its alternatives which is inventive. Compounds embraced by the claims are so diverse in nature that a prior art anticipating a claim with respect to one member under 35 USC 102 would not render obvious the same claim under 35 USC 103. This is evidentiary of patentably distinct and independent inventions.

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Note that compounds, corresponding compositions, a method of use and a process of making that are of the same scope are considered to form a single inventive concept under PCT Rule 13.1, 37 CFR 1.475(d).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-9, 12-14, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin et al. (Bioorganic & Medicinal Chemistry Letters 9 (22) (1999), pages 3237-3242). The claims read on the compound 14 (see Scheme 2, page 3239).

Claims 7-9, 12-14, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Guihard et al. (Journal of Organic Chemistry (1999), 64 (23), 8702-8705). The claims read on the compounds of RN 254100-96-4; 254100-97-8; 254100-98-6; 254100-99-7; 254101-00-3 and 254101-01-4 (see attached CAS abstract and structures).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9, 12-14, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable independently over Lin et al. (Bioorganic & Medicinal Chemistry Letters 9 (22) (1999), pages 3237-3242) and Guihard et al. (Journal of Organic Chemistry (1999), 64 (23), 8702-8705). These references teach structurally similar compounds that differ from the instantly elected compound by the nature of the protecting group. That is, the instant elected compound has Fmoc as a protecting group over BOC or CBZ of these references. However, one protecting group renders another prima facie obvious. Thus, one skilled in the art would be motivated to replace Fmoc by CBZ or BOC with the expectation of achieving similar results.

Claims drawn to the process of making the claimed compounds are withdrawn from consideration because art was found (see MPEP 803.02.)

Applicants are also advised of MPEP 803.02 Restriction - Markush Claims [R - 2], fourth paragraph, where is stated;

“As an example, in the case of an application with a Markush - type claim drawn to the compound C - R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush - type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush - type

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claim and claims to the elected species shall be rejected, and claims to the non - elected species would be held withdrawn from further consideration. As in the prevailing practice, **a second action on the rejected claims would be made final.**" (emphasis added).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

September 17, 2002



**Bruck Kifle**  
**Primary Examiner**  
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